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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,519	12/14/2001	Hiroshi Shibata	2271/66463	8255

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EXAMINER
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TEACHEY, ROBERT

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/017,519	<b>Applicant(s)</b> SHIBATA, HIROSHI	
	<b>Examiner</b> Robert Teachey	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 1–7 are pending.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The references listed in the information disclosure statement (IDS) submitted on 12/14/2001 have been considered by the examiner.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3, and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, and 6 of copending Application No. 09/846991. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, and 5 are disclosed in claims 1, 2, 5, and 6 of copending application 09/846991.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim 1 recites a system for reporting status of and offering service to an image communication terminal, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a communications terminal apparatus, comprising: a communications system configured to perform electronic communications with a manager supervising said apparatus. The image communication terminal is the same as the communications terminal apparatus. Claim 1 recites a manager personal computer, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a manager. Claim 1 recites a service center, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a service depot. Claim 1 recites a registering part, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a register. Claim 1 recites a controlling part, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a controller. Claim 1 recites a registering part for registering an e-mail address of said manager, an e-mail address of said service center and identification information of said image communication terminal; an e-mail controlling part for exchanging e-mails via said network, which is an obvious variation of claim 2 of copending application 09/846991 that recites a communications terminal apparatus as defined in claim 1, wherein said communications system performs E-mail communications with said manager; and claim 6 of copending application 09/846991 that recites communications terminal apparatus as defined in claim 5, wherein said communications system performs E-mail communications with said manager and said service depot.

Claims 1, 3, and 5 recite a status detecting part, which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a detector. Claim 1 recites a status detecting part for detecting statuses of said image communication terminal, claim 3 recites said status detecting part includes consumables detecting part for detecting shortage status of the consumables for resources of said image communication terminal, claim 5 recites said status detecting part includes maintenance/failure detecting part for detecting necessity of maintenance or failure status of said image communication terminal which is an obvious variation of claims 1 and 5 of copending application 09/846991 that recite a detector automatically detecting a status of usage of a consumable product used in said apparatus and supplied by a service depot and a detector automatically detecting an event indicative of a defect in a maintenance component used in said apparatus respectively.

### ***Specification***

6. The disclosure is objected to because of the following informalities:

Step 19 of figure 4A is not explained.

Step 28 of figure 5 is not explained.

Appropriate correction is required.

***Claim Objections***

7. Claims 1-7 are objected to because of the following informalities:

Regarding claims 1-3, 5, and 7, "manager" should be changed to "manager personal computer" (page 30 lines 15, 23; page 31 lines 5, 13, 14, 24; page 32 line 5; page 33 lines 6, 11, 12; page 34 line 12). Appropriate correction is required.

Regarding claims 4 and 6, "as claimed in claimed" should be changed to "as claimed " (page 32 line 13 and page 33 line 19). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

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application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by over Sampath et al. (hereinafter referred to as Sampath) (U.S. Patent 6,892,317).

With respect to claim 1, Sampath discloses a system for reporting status of and offering service to an image communication terminal (column 2 lines 52-54 and column 3 lines 62-65), said system comprising an image communication terminal (column 1 lines 36-38); a manager personal computer connected to said image communication terminal via a network (column 3 lines 62-67 and column 4 lines 1-15); and a service center connected to said image communication terminal via said network (column 4 lines 28-38 and column 10 lines 65-67); said image communication terminal including a registering part for registering an e-mail address of said manager, an e-mail address of said service center and identification information of said image communication terminal (column 3 lines 1-5, 44-50); an e-mail controlling part for exchanging e-mails via said network (column 4 lines 21-26); and a status detecting part for detecting statuses of said image communication terminal (column 4 lines 60-63 and column 6 lines 5-7), wherein said service center receives and registers said identification information and said e-mail address of said manager from said image communication terminal (column 7 lines 46-53 and column 10 lines 65-67); and when statuses of said image communication terminal detected by said



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status detecting part are sent from said image communication terminal to said service center by said mail controlling part using an e-mail, various information corresponding to said statuses are informed to said manager through a WEB (World Wide Web) site of said service center (column 3 lines 1-5, column 4 lines 6-10, column 8 lines 61-67, and column 9 lines 1-39).

With respect to claim 2, Sampath discloses the system wherein said various information from said service center is informed to said manager using an e-mail with a URL (Uniform Resource Locator) of a homepage of said manager (column 3 lines 1-5, column 7 lines 36-67, column 8 lines 1-67, column 9 lines 1-3, and column 10 lines 38-63).

With respect to claim 3, Sampath discloses the system wherein said status detecting part includes consumables detecting part for detecting shortage status of the consumables for resources of said image communication terminal (column 6 lines 58-64) and transmitting part for sending consumables shortage information, said e-mail address of the manager and said identification information of said image communication terminal are sent to said service center in case there is a shortage of the consumables (column 7 lines 36-42 and column 8 lines 13-16), and upon reception of said various information sent from said transmitting part, said service center sends an e-mail to said manager, said e-mail including a URL of a homepage which enables introduction and ordering of

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consumables from the WEB-site (column 3 lines 1-5, column 4 lines 6-10, column 8 lines 12-47, and column 11 lines 12-16).

With respect to claim 4, Sampath discloses the system wherein said service center includes type-of-consumables information for each of said image communication terminal (column 7 lines 9-42 and column 8 lines 13-16) and comprises: introducing means for introducing consumables for the image communication terminal installed at the user location, ordering means for the user to order consumables on the homepage and informing means for informing time and date of delivery of consumables on the homepage (column 7 lines 46-60, column 8 lines 12-47, and column 11 lines 12-16).

With respect to claim 5, Sampath discloses the system wherein said status detecting part includes maintenance/failure detecting part for detecting necessity of maintenance or failure status of said image communication terminal and transmitting part for sending maintenance/failure information (column 5 lines 39-50 and lines 64-67), said e-mail address of the manager and said identification information of said image communication terminal are sent to said service center (column 6 lines 5-7, 58-65), and upon detection of a state where maintenance or repair is necessary, said service center sends an e-mail about said various information to said manager, said manager is informed of information corresponding to said maintenance/failure status information from a

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WEB-site of said service center (column 3 lines 1-5, column 7 lines 36-45, column 8 lines 34-47, and column 11 lines 7-11).

With respect to claim 7, Sampath discloses the system wherein said image communication terminal sends an e-mail informing completion of replenishment of said consumables or completion of maintenance/repair of the resource (column 8 lines 13-60 and column 10 lines 8-13), and upon reception of said e-mail, said service center deletes the message informed by said manager from the homepage (column 3 lines 1-5 and column 11 lines 23-33).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sampath in view of Haines (U.S. Patent 6,370,341).

With respect to claim 6, Sampath discloses the system wherein said service center includes failure information or maintenance information for each of

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said image communication terminal and comprises: introducing means for introducing information indicating time and date when the service-person is available (column 7 lines 54-60, column 8 lines 61-67, and column 9 lines 1-3)

Sampath differs from claim 6 in that Sampath does not disclose introducing information related to new-product guide information.

Haines discloses introducing information related to new-product guide information (figure 6 and column 9 lines 54-56).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Sampath wherein information related to new-product guide information is introduced.. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Sampath by the teaching of Haines so that Sampath's invention could provide new-product guide information to effect the repair/maintenance (given the express suggestion of Sampath column 10 lines 57-58).

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**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Teachey whose telephone number is 571-272-2906. The examiner can normally be reached Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*R.T.*  
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SUPERVISORY PATENT EXAMINER